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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/944,954      | 09/01/2001  | Philip M. Beart      | SYM 116/118         | 2713             |

23579 7590 07/09/2003

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| EXAMINER |
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WEGERT, SANDRA L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1647

DATE MAILED: 07/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/944,954

Applicant(s)

BEART ET AL.

Examiner

Sandra Wegert

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to a method of identifying compounds that bind to or modulate glutamate transporters, classified in class 435, subclass 7.1+.
- II. Claims 25-26, drawn to a compound identified by the above method, classified in class 260, subclass 998.2+.
- III. Claim 27, drawn to a method of treatment, classified in class 260, subclass 998.2+.

The inventions are distinct, each from each other because of the following reasons:

Invention I is related to Invention II as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the binding methods can be used to identify other ligands for other receptors.

Inventions I and III are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials,

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process steps and goals. Invention I is a competitive binding assay, used to find substrates of a glutamate transporter. Invention III is a method of treating animals for a glutamate transporter-related disorder.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

### ***Restriction***

Furthermore, restriction to one of the following inventions is required under 35 U.S.C.

121. If Applicant elects Invention I, he/she must also choose one "receptor compound."

Pick one:

A) a receptor compound\*.

(\* Please specify compound by a standard naming system, or reference to a chemical or structural formula from the Specification; i.e: "[sup.3H]-(2S,4R)-4-methylglutamate").

The compounds are independent and distinct, each from the other, because each chemical structure a non-coextensive search.

### ***Restriction***

Furthermore, restriction to one of the following inventions is required under 35 U.S.C. 121:

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- A) The Inventions as they pertain to the GLAST transporter.
- B) The Inventions as they pertain to the GLT1 transporter.
- C) The Inventions as they pertain to the EAAT1 transporter.
- D) The Inventions as they pertain to the EAAT2 transporter.

Inventions A) through D) are independent and distinct, each from the other, because each transporter is a separate polypeptide, with a distinct function and requires a non-coextensive search.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant must pick one invention from I-III above as well as one receptor compound -if Invention I was elected- as well as one transporter protein. Applicant is advised that all elections above are restriction requirements not species election requirements.

Applicant is advised that the reply to this requirement to be complete must include an election of the inventions to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17 (h).

***Advisory information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (703) 308-9346. The examiner can normally be reached Monday - Friday from 9:30 AM to 6:00 PM (Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SLW

6/30/03

*Elizabeth C. Kemmerer*

ELIZABETH KEMMERER  
PRIMARY EXAMINER